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PATENT

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

Reissue Application No. : 09/553,413

Applicants/Appellants : Briere, *et al.*

Filed : April 20, 2000

Title : **BLOW MOLDING DEVICE FOR PRODUCING
THERMOPLASTIC CONTAINERS**

Art Unit : 1722

Examiner : Robert B. Davis

Confirmation No. : 5942

Attorney Docket No. : 11496/195086

Customer No. : 00826

Mail Stop Appeal Brief – Patents
Commissioner for Patents
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REPLY BRIEF

(37 C.F.R. § 1.193; Application for Reissue of a Patent)

This Reply Brief in the above-identified application for reissue of U.S. Patent No. 5,968,560 is filed in response to the Examiner's Answer dated June 7, 2005.

ARGUMENT

- I. THE SHELL HOLDERS, AS CLAIMED IN INDEPENDENT CLAIMS 15, 35, 36, AND 39, INCLUDE THE MOLD CARRIER SHAPE LIMITATION.

The reissue claims do not recapture surrendered subject matter because the mold carrier shape continues to be a required characteristic of the claimed article. The article in the reissue claims, a mold assembly, generally comprises two mold shells, two mold shell holders "shaped to be supported by two mold carriers made in the form of enveloping structures," and at least one

quick-fixing locking member. The shell holders, as claimed, include the mold carrier shape limitation, which is precisely the substance of the amendment made during prosecution of the original patent application.

**A. The Surrendered Subject Matter Involves the Mold Carrier Shape,
Not the Mold Carrier Itself.**

During prosecution of the original patent application, claim 1 recited a device for manufacturing containers including at least one mold assembly, which consist of two half-molds respectively supported by two mold carriers, wherein each half-mold comprises a shell and a shell holder. (*See* Claim 1 in the Appeal Brief, Appendix C). The claim amendment entered during the original prosecution altered only the mold carrier shape. The mold carriers were present as elements of the combination before the amendment in question.

Thus, only the mold carrier shape was amended to overcome the prior art. Claim 1 of the original patent was amended to add the phrase, “which are made in the form of enveloping structures and” and to delete the phrase – in particular bottles –. (*See* Appendix C). Following the amendment, a Notice of Allowability was mailed and the ‘560 patent issued. The subject matter surrendered during prosecution of the machine claim was: a device without the enveloping characteristic of the mold carriers.

The examiner’s insistence that the “two mold carriers” limitation represents the surrendered subject matter is not supported by the facts from the original prosecution. The mold carriers were not added to claim 1 in order to overcome a prior art rejection. Only the mold carrier shape was amended. The recapture rule only prevents recovery of the surrendered subject matter; nothing more. The distinguishing characteristic of “mold carriers made in the form of

enveloping structures” is present in both the original patent claim and the reissue claims. Because the amended feature remains present in the reissue claims, there is no recapture.

The examiner argues that the claim language “said shell holders being shaped to be supported by two mold carriers made in the form of enveloping structures movable one with respect to the other” does not actually limit the structure of the shell holders. The appellants disagree. This limitation excludes from coverage all shell holders that cannot be supported by mold carriers that have the required enveloping characteristic.

B. The Appellants Did Not Surrender the Option of Claiming the Invention as an Article of Manufacture Instead of a Machine.

A mold assembly is the article of manufacture being claimed in the reissue application. The assertion in the Examiner’s Answer that the blow-molded plastic container must be the article of manufacture is not supported by the facts or the prosecution history. The appellants’ invention may be described and claimed as a machine, as an article of manufacture, or as patentable subject matter in any the statutory category. The patented claim recites a “device for manufacturing containers,” which is a machine under 35 U.S.C. § 101. The reissue claims recite a “mold assembly,” which is a manufacture (*i.e.*, an article of manufacture) under Section 101. Nothing in the prosecution history supports the position that the only article of manufacture associated with the machine must be the bottle produced by the machine. Moreover, nothing in the prosecution history suggests the appellants ever surrendered the option of claiming the invention in a different statutory category.

The examiner states he “does not believe that the subcombination of the mold assembly is an article of manufacture in relation to the device for manufacturing containers.” To the extent

this statement acknowledges that an article of manufacture can also be a subcombination, the appellants agree. However, the examiner provides no basis for his stated belief that this subcombination cannot also be an article of manufacture, and his position implies a restrictive (unstated) definition of the term “article of manufacture.” Certainly many components of machines, such as the mold assembly claimed here, are capable of being made and sold as separate articles of manufacture.

Regardless of whether the mold assembly in an article of manufacture, the “switch from combination to subcombination” of the present reissue application is fully analogous to the situation dealt with in *Ex parte Wikdahl*, 10 U.S.P.Q.2d 1546 (BD. PAT. APP. & INTERF. 1989) and discussed in MPEP § 1412.02 (described in detail in the appellants’ Appeal Brief). The logic in *Wikdahl* of allowing a change in preamble from claiming a software process to claiming the software code as an article during reissue applies equally well to this case, where the change in preamble is from a device for manufacturing containers to a mold assembly used in the device. The examiner has arbitrarily suggested that *Wikdahl* should be restricted to its facts, but has noted no differences in the respective factual situations that would limit the logic of *Wikdahl* to its particular facts or to facts unlike those before the Board in the present case.

II. A PRECISE ANALYSIS OF THE SUBJECT MATTER SURRENDERED AND THE BROADENING ASPECT OF THE CHANGE IN STATUTORY CATEGORY DEMONSTRATES THERE IS NO RECAPTURE.

The reissue claims are not barred because there is no recapture of surrendered subject matter and the reissue claims are broader in an aspect unrelated to the rejection. The reissue claims in this case fall squarely into the paragraph 3(b) of the *Clement* test. Paragraph 3 states:

If the reissue claims are broader than the surrendered subject matter in some aspects and narrower than the surrendered subject matter in other respects, and [subparagraph (b)] if the reissue claims are narrower in an aspect germane to the prior art rejection and broader in an aspect unrelated to the rejection, the recapture rule will not bar the reissue claims. *Ex parte Eggert*, 67 U.S.P.Q.2d 1716, 2003 WL 21542454, at *13 (BD. PAT. APP. & INTERF. May 29, 2003); *In re Clement*, 131 F. 3d 1464, 1469-70 (Fed. Cir. 1997).

- Applying Paragraph 3: The reissue claims are narrower than the patent claim prior to amendment (*i.e.*, narrower than the surrendered subject matter) in that the ability of the shell holders to be supported by mold carriers in the form of enveloping structures continues to be required in the reissue claims.
- The reissue claims are also broader than the surrendered subject matter because the reissue claims are directed to an article of manufacture instead of a machine. *See* MPEP § 1412.02.
- Applying subparagraph (b): The narrowing aspect (continuing to require the enveloping characteristic of the mold carriers) is germane to the rejection because the shape was limited by amendment and remains a limitation of the shell holders in the reissue claims. There are many types of mold carriers, only some of which are made in the form of an enveloping structure.

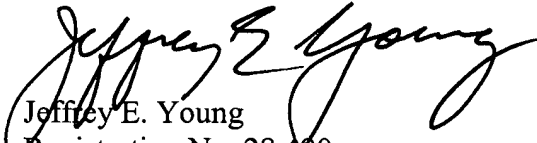
- The broadening aspect (claiming the article corresponding to the machine) is not germane to the rejection, because a change in statutory category is not germane to the rejection, and because the article claim is patentable over the prior art as determined by the examiner during prosecution of the reissue application.

Accordingly, under *Clement* and *Ex parte Eggert*, the requirements of paragraph 3(b) of the *Clement* test are satisfied and the recapture rule does not bar the reissue claims.

III. CONCLUSION.

The enveloping mold carrier shape limitation is present in the claims being sought in the reissue application. The change in statutory category resulting from claiming the invention as an article of manufacture instead of a machine is a broadening aspect not germane to the rejection. Because there is no recapture of surrendered subject matter and the reissue claims are broader in an aspect unrelated to the rejection, the reissue claims are not barred by the recapture rule. Moreover, because the reissue claims are patentably distinguishable and allowable over the prior art¹, the reissue claims are in condition for immediate allowance.

Respectfully submitted,


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¹ See, e.g., the first Office Action dated Feb. 28, 2001, at 6; the first Notice of Allowability dated March 22, 2001; the second Notice of Allowability dated May 30, 2001; and, the second Office Action dated March 18, 2002, at 2.

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